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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,511	01/16/2002	Roy D. Kornbluh	SRI1P035/US-4237-2	1563
22434	7590	04/07/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			BUDD, MARK OSBORNE	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	
			2834	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 2834

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-96 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments to the specification and claims constitute new matter not found in the original disclosure. No explicit language can be found in the original disclosure to support "said deflection resulting --- at least about 10% ----". Applicant states the amendatory material finds basis in "US application 09/619848 which was incorporated by reference in the present application". However, the examiner has not been able to find any such reference in applicant's original disclosure.

Assuming, arguendo, that the examiner has overlooked a valid incorporation, the added limitation cannot be seen as critical in any way, shape or form since it is not even implicitly noted in the original disclosure.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-88 and 93-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pottenger, Hubbard or Lee.

The references teach the basic transducer system using an electroded piezoelectric polymer operating in a bending mode to control stiffness of and/or provide driving and damping of a device. They do not mention a minimum increase or decrease in surface area during operation. Also, they do not explicitly teach some of the system details such as drive voltage levels buffer capacitors, plural active areas on a single electro-active element and particular resistor values. However, it has long been held that optimization of a known device for a particular specification is within the skill expected of the routineer. Likewise duplication of parts and/or making parts integral or separable are manipulations with the skill expected of the routineer. Thus to provide plural active areas on a single electro-active element (rather than plural separate elements) and providing optimum circuit values would have been obvious to one of ordinary skill in the art.

Claims 80-92 are rejected under 35 USC 103(a) as being unpatentable over Pottenger, Hubbard or Lee in view of Lazarus or Spangler.

Pottenger, Lee and Hubbard teach using one electro-active polymer transducer in a drive/damp servo system to control a desired device. They do not explicitly apply their systems to footwear. However, Lazarus and Spangler both teach it is well known to use an electro-active transducer to control parameters of footwear. It would have been obvious to use the specific polymer material of Lee, Hubbard or Pottenger in Lazarus or Spangler since selection from among known suitable materials has long

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been held to be within the skill expected to the routineer. Conversely, it would have been obvious to use the electro-active polymer drive, damping system to any particular device known to benefit from a drive/damp application; including footwear (as taught by Spangler or Lazarus).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Budd/ds

03/24/03

MARK U. BUDD
PRIMARY EXAMINER
ART UNIT 219

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-96 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments to the specification and claims constitute new matter not found in the original disclosure. No explicit language can be found in the original disclosure to support "said deflection resulting --- at .least about 10% ----". Applicant states the amendatory material finds basis in "US application 09/619848 which was incorporated by reference in the present application". However, the examiner has not been able to find any such reference in applicant's original disclosure.

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